



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/687,826

10/20/2003

Mark Alan Jackson

60497.000009

9915

21967 7590 04/15/2008

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

MARTINEZ, BRITTANY M

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/687,826	Applicant(s) JACKSON, MARK ALAN	
	Examiner BRITTANY M. MARTINEZ	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

Applicant's arguments/remarks and amendments filed on January 7, 2008, have been carefully considered. **Claims 1-28** are pending in this application, with **Claims 1-12** examined and **Claims 13-28** withdrawn in view of the restriction requirement made August 2, 2007. Examiner acknowledges that Applicant traverses this restriction requirement based on the argument that search and examination of all the instant claims can be made without serious burden to the Examiner. Examiner respectfully disagrees. There would be a serious search and examination burden to the Examiner, as evidenced by the inventions having acquired a separate status in the art in view of their different classification and requiring a different field of search. *Therefore the restriction requirement is made **FINAL**.*

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602) in view of Bergstrom et al. (US 6,445,146) and Wilson et al. (US 4,943,781), as applied in the prior Office action.

Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602), Bergstrom et al. (US 6,445,146), and Wilson et al. (US 4,943,781) in view of Applicant's own disclosure, as applied in the prior Office action.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602), Bergstrom et al. (US 6,445,146), and Wilson et al. (US 4,943,781) in view of Wiberg et al. (US 6,392,246), as applied in the prior Office action.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602), Bergstrom et al. (US 6,445,146), and Wilson et al. (US 4,943,781) in view of Strawson (US 6,437,344), as applied in the prior Office action.

Claims 1-2, 6, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602), Bergstrom et al. (US 6,445,146), and Wilson et al. (US 4,943,781) in view of Ashley et al. (US 4,428,908), Zhu et al. (US 5,927,351), and Armel (US 3,411,002), as applied in the prior Office action.

Claims 1-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabiri et al. (US 5,037,602), Bergstrom et al. (US 6,445,146), and Wilson et al. (US 4,943,781) in view of Wiberg et al. (US 6,392,24.6) and Zhu et al. (US 5,927,351), as applied in the prior Office action.

Response to Amendments

Applicant's amendments, filed January 7, 2008, with respect to the Specification and Drawings have been fully considered and are accepted. The objections to the Specification and Drawings, filed September 6, 2007, have been withdrawn.

Response to Arguments

1. Applicant's arguments regarding the Claim Rejections under 35 U.S.C. § 103, filed January 7, 2008, have been fully considered but they are not persuasive.
2. In response to applicant's argument that there is no suggestion to combine the references (Dabiri, Bergstrom, and Wilson teach away from each other), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art to modify the transportable radioisotope production facility of Dabiri with the cyclotron of Bergstrom and Wilson because the space limitations presented by an ordinary cyclotron in a transportable facility (Dabiri, column 2, lines 49-68) could be overcome by a more compact cyclotron (Bergstrom, column 2, lines 64-67; column 3, lines 1-5 and 60-65).

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no iron yoke) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the argument that Wilson teaches away from Bergstrom is irrelevant.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRITTANY M. MARTINEZ whose telephone number is (571) 270-3586. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wayne Langel/
Primary Examiner, Art Unit 1793

BMM

/Brittany M Martinez/
Examiner, Art Unit 1793